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PATENT
979-1-017

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT(S)	:	Siegfried Hekimi *et al*	EXAMINER	:	K. Canella
SERIAL NO.	:	09/513,151	ART UNIT	:	1642
FILED	:	February 25, 2000			
FOR	:	CAENORHABDITIS ELEGANS GRO-1 GENE			

CERTIFICATE OF MAILING UNDER 37 CFR 1.8

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RESPONSE TO RESTRICTION REQUIREMENT
UNDER 35 U.S.C. §121

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

Dear Sir:

This is in response to a Requirement for Restriction mailed November 13, 2000 requiring Applicant to elect between the following groups of claims for further prosecution:

Group I. Claims 1-6, drawn to GRO genes and GRO co-expressed genes, classified in class 536, subclass 23.1.

Group II. Claims 7-13, drawn to GRO proteins and GRO co-expressed proteins, classified in class 514, subclass 2.

Group III. Claim 15, drawn to a mouse lacking the murine gene homologous to the GRO gene, classified in class 800, subclass 10.

Group IV. Claim 14, drawn to a method of diagnosing cancer in a patient comprising analyzing a DNA sample from the patient for alterations in the GRO gene, classified in class 436, subclass 64.

Group V. Claims 16-20, drawn to methods for regulating physiological processes comprising administering a compound which interferes with the enzymatic activity of GRO protein and co-expressed proteins, classified, for example, in class 530, subclass 350.

In accordance with 35 U.S.C. §121, Applicant hereby elects to prosecute the claims of Group I, drawn to GRO genes and GRO co-expressed genes, classified in class 536, subclass 23.1, with traversal.

Under 35 U.S.C. §121 "two or more independent and distinct inventions ... in one application may ... be restricted to one of the inventions." Inventions are "`independent'" if "there is no disclosed relationship between the two or more subjects disclosed" (MPEP 802.01). The term "`distinct'" means that "two or more subjects as disclosed are related ... but are capable of separate manufacture, use or sale as claimed, and are patentable over each other" (MPEP 802.01). However, even with patentably distinct inventions, restriction is not required unless one of the following reasons appear (MPEP 808.02):

1. Separate classification
2. Separate status in the art; or
3. Different field of search.

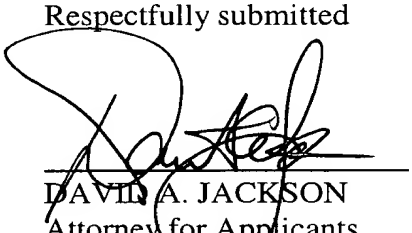
Under Patent Office examining procedures, "If the search and examination of an entire application can be made without serious burden, the Examiner is encouraged to

examine it on the merits, even though it includes claims to distinct or independent inventions" (MPEP 803, Rev. 8, May 1988).

Specifically, the claims set forth in at least Groups II and IV should be considered conjointly with those of Group I, inasmuch and to the extent that the primary definition in these first-mentioned claims relies upon the Group I gene identification for definition. Thus, a claim directed to a protein which in turn is defined by the gene that encodes it would seem to require a search of the operative gene for the determination of patentability. Likewise, to the extent that the method of Claim 16 relies upon the GRO-1 gene of Claim 7 (and consequently, Claims 2 and 3), it should likewise be conjointly considered. For these reasons, traversal of the above requirement is believed to be appropriate and is hereby stated.

For the above reasons, Applicants' request withdrawal of the Requirement for Restriction, and early action on the merits as to all of the claims presently pending in the case.

Respectfully submitted



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